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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------|------------------|
| 10/726,629  | 12/04/2003  | Hideki Sato          | 046601-5124              | 5727             |
| 9629  | 7590        | 03/18/2005           | EXAMINER<br>NGO, HOANG X |                  |
| MORGAN LEWIS & BOCKIUS LLP<br>1111 PENNSYLVANIA AVENUE NW<br>WASHINGTON, DC 20004 |             |                      | ART UNIT<br>2852         | PAPER NUMBER     |

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/726,629

**Applicant(s)**

SATO ET AL.

**Examiner**

Hoang Ngo

**Art Unit**

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/4/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nobuhiro et al.

Nobuhiro et al disclose a detachable unit 41 comprising a memory part 49 storing information containing control information, and upon mounting the detachable unit on an image forming apparatus main member, operation of the image forming apparatus being controlled based on the information stored in the memory part (see Abstract).

Nobuhiro et al further disclose the memory part stores control information corresponding to a destination of the detachable unit (Para. 0016); the control information stored in the memory part of the detachable unit is updated 1 times corresponding to destination from a manufacturer to an end customer of the detachable unit (Para. 0016), the control information stored in the memory part is capable of being updated when mounted (Para. 0033); the detachable unit having a reception part 52 and 53 for receiving an external signal; the control information stored

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in the memory part is updated at least once from an initial state (Para. 0048); the memory part of the detachable unit stores specification information and history information of the detachable unit (Para. 0048); the detachable is a fixing unit (Abstract); the image forming apparatus having an output means (i.e. display unit, Para. 0048) for outputting information to a user; the control means 51 outputs the information for time of replacement to the output means (Para. 0048).

3. Claims 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayward et al.

Hayward et al disclose a server computer 40 for communicating with plural client computers 30 through an information communication network (i.e. Internet, Fig. 8), the server comprises storing control information corresponding to the client computers and transmitting the control information to the client computers and the control information being information for controlling the image forming apparatus (Col. 4, lines 56-67).

Hayward et al further disclose a writing device for writing control information obtained from the client computer on a memory part of a detachable unit detachable to an image forming apparatus (Col. 4, lines 56-67).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobuhiro et al in view of Hayward et al.

As discussed above, Nobuhiro et al, disclose every aspect of applicant's claimed invention except for the memory part storing advertisement information showing advertisement as the control information, and printing the advertisement information on a recording sheet upon forming an image.

Hayward et al disclose a memory part storing advertisement information showing advertisement as the control information and printing the advertisement information on a recording sheet upon forming an image (Col. 6, lines 28-48).

It would have been obvious to one having ordinary skill in the art at the time the invention was made in incorporate the memory part as taught by Hayward et al to the device of Nobuhiro et al so that information relating to the detachable unit can be quickly relayed to the user.


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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Ngo whose telephone number is (571) 272-2138. The examiner can normally be reached on 6:00am - 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Hoang Ngo  
Primary Examiner  
Art Unit 2852

Hn